

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today
(1) was not written for publication in a law journal and
(2) is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte VANCE M. KRAMER, JR.

Appeal No. 97-2966
Application 08/393,858¹

ON BRIEF

Before MCCANDLISH, **Senior Administrative Patent Judge**, and
MEISTER and MCQUADE, **Administrative Patent Judges**.

MEISTER, **Administrative Patent Judge**.

DECISION ON APPEAL

Vance M. Kramer, Jr. (the appellant) appeals from the
final rejection of claims 7-9, the only claims remaining in

¹ Application for patent filed February 24, 1995.
According to appellant, this application is a division of
Application 08/248,097, filed May 24, 1994.

the application.

We REVERSE and, pursuant to our authority under the provisions of 37 CFR § 1.196(b), enter a new rejection of the appealed claims under 35 U.S.C. § 103.

The appellant's invention pertains to a length of rubber tubing with axially spaced circumferentially corrugated segments which has been made by a particular process. Independent claim 7 is further illustrative of the appealed subject matter and reads as follows:²

7. A length of rubber tubing of uniform wall thickness throughout its length and with axially spaced circumferentially corrugated segments, made by the process comprising the steps of:

- a) positioning an end length of a sleeve of uncured rubber over an end portion of a forming mandrel;
- b) positioning about said end length, an axially extensible, resilient forming member with sleeve-engaging convolutions so that there is space between the convolutions;
- c) expanding said end length of said sleeve radially into engagement with said convolutions;

² Contrary to the examiner's statement on page 3 of the answer that the copy of the appealed claims in the appendix to the brief is correct, we note that in subparagraph h) of claim 7 (as reproduced in the appendix to the brief) "steps 3 through g" should read -- steps c through g --.

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d) axially foreshortening said forming member and said radially expanded end length of said sleeve, concertina fashion to cause circumferential portions of said sleeve to be pressed between convolutions of said forming member, to form at least rudimentary corrugations in said end length;

e) axially extending said forming member and said end length of said sleeve while radially collapsing said end length;

f) moving said sleeve axially along said mandrel to a new axial location;

g) moving said forming member axially relative to said sleeve to a new length portion of said sleeve axially spaced from said end length;

h) repeating steps c through g until a desired number of length portions with rudimentary corrugations are formed;

i) removing said forming member from said sleeve; and

j) curing said sleeve to provide a length of tubing with a plurality of axially spaced corrugated segments and with a uniform wall thickness.

No prior art has been relied on by the examiner.

Prior art relied on by this merits panel of the Board is:

Kramer et al. (Kramer)	3,304,581	Feb. 21,
1967		

The prior art set forth by the appellant in lines 23-31 of page 2 of the specification (the admitted prior art).

Claims 7-9 stands rejected under 35 U.S.C. § 112, first paragraph, as being based upon an original disclosure which

fails to provide descriptive support for the subject matter now being claimed. According to the examiner, there is no support in the original disclosure for the recitations set forth in independent claim 7 of the tubing being "of uniform wall thickness throughout its length" and that the sleeve is cured "with a uniform thickness."

We will not support the examiner's position. As the appellant has argued:

The present application when filed, incorporated by reference several U.S. patents [see specification, page 1] that provide support for the claimed feature whereby the tubing produced by the recited process, has a uniform wall thickness. The patents referred to are Nos. 3,168,604; 3,304,581; 3,669,586; 3,705,780; 3,975,129; 4,053,275; and 4,113,828. All of these U.S. patents issued prior to the effective filing date (May 24, 1994) of the present application. The present application recites that the invention relates to an unique variation of the method and apparatus for the manufacture of tubing in accordance with those patents. [Brief, page 6.]

The examiner recognizes this but, nevertheless, takes the position that there is no specific indication that the "uniform wall thickness" disclosed by these references³ is

³ See column 1, line 15, and column 3, line 12, of Patent No. 3,168,604; column 1, lines 18 and 19, and column 2, line (continued...)

intended for use in the claimed length of rubber tubing. We do not agree. Page 1 of the specification expressly states that the invention relates to the manufacture of "such tubing in accordance with" the above-noted patents. In our view, this statement provides a specific indication that the tubing of the instant invention has the same features (including a uniform wall thickness) as those disclosed by the patents which are incorporated by reference. This being the case, we share the appellant's view that there is adequate descriptive support for the limitation of a "uniform wall thickness" as claimed.

In view of the foregoing, we will not sustain the rejection of claims 7-9 under 35 U.S.C. § 112, first paragraph.

Under the provisions of 37 CFR § 1.196(b) we make the following new rejection.

Claims 7-9 are rejected under 35 U.S.C. § 103 as being

³(...continued)
70, of Patent No. 3,304,581; column 1, lines 13, 33 and 34, of Patent No. 3,699,586; column 1, lines 13 and 14, of Patent No. 3,705,780; column 5, line 5, of Patent No. 4,053,275; and column 5, line 8, of Patent No. 4,113,828.

unpatentable over the admitted prior art in view of Kramer. The admitted prior art states that "[i]n the past" tubing having axially spaced corrugated length portions has been made by using plural forming devices at axially spaced length portions of the uncured rubber sleeve. Thus, according to the admitted prior art, a length of rubber tubing with axially spaced circumferentially corrugated segments is known in the art (albeit formed by a different process). To the extent that the tubing of the admitted prior art might not have a "uniform wall thickness," Kramer's teaching of a "uniformity in a wall thickness" (column 1, lines 18 and 19) would have fairly suggested such an arrangement, particularly where economical manufacture is of concern (see column 1, line 17). Although the tubing of the admitted prior art is formed by a different process, we must point out that the determination of patentability in a product-by-process claim is based on the product itself, even though the claim may be limited and defined by the process. That is, the product in such a claim is unpatentable if it is the same as or obvious from the product of the prior art, even if the prior product was made by a different process. ***In re Thorpe***, 777 F.2d 695, 697, 227

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USPQ 964, 966 (Fed. Cir. 1985).

In summary:

The rejection of claims 7-9 under 35 U.S.C. § 112, first paragraph, is reversed.

A new rejection of claims 7-9 has been made under 35 U.S.C. § 103.

This decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b)(amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)).

37 CFR

§ 1.196(b) provides that, "A new ground of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that the appellant,
WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of

the following two options with respect to the new ground of

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rejection to avoid termination of proceedings (§ 1.197(c)) as
to the rejected claims:

(1) Submit an appropriate amendment of the
claims so rejected or a showing of facts relating to
the claims so rejected, or both, and have the matter
reconsidered by the examiner, in which event the
application will be remanded to the examiner. . . .

(2) Request that the application be reheard
under § 1.197(b) by the Board of Patent Appeals and
Interferences upon the same record. . . .

No time period for taking any subsequent action in
connection with this appeal may be extended under 37 CFR
§ 1.136(a).

REVERSED
37 CFR § 1.196(b)

HARRISON E. MCCANDLISH, Senior)	
Administrative Patent Judge)	
)	
)	
)	
JAMES M. MEISTER)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
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)	
JOHN P. MCQUADE)	
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